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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,543	05/15/2006	Per Sonne Holm	BOH06278P00210US	7495
38939 7590 06/23/2008 DYKEMA GOSSETT PLLC 10 S. WACKER DR., STE. 2300 CHICAGO, IL 60606				
EXAMINER				
SGAGIAS, MAGDALENE K				
ART UNIT		PAPER NUMBER		
1632				
MAIL DATE		DELIVERY MODE		
06/23/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/579,543

Applicant(s)

HOLM, PER SONNE

Examiner

MAGDALENE K. SGAGIAS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-103 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-103 are pending.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) **1-54**, drawn to an adenovirus expressing a first protein which is selected from the group comprising an E1B protein and an E4 protein, prior to a second protein which is selected from the group comprising an E1A-protein.

Group II, claim(s) **55-58**, drawn to a replication system comprising a nucleic acid according to claim 54 and a nucleic acid of a helper virus, whereby the nucleic acid of the helper virus comprises one or more of the expression cassettes of the adenovirus according to any of claims 1 to 53.

Group III, claim(s) **59-61**, drawn to a cell comprising an adenovirus according to any of claims 1 to 53 and/or a nucleic acid according to claim 54 and/or a replication system according to claim 55 or 56 and/or a vector according to claim 57 or 58.

Group IV, claim(s) **62**, drawn to an organism, preferably a mammal organism, comprising an adenovirus according to any of claims 1 to 53, a nucleic acid according to claim 54, a replication system according to claim 55 or 56, a vector according to any of claims 57 or 58 or a cell according to any of claims 59 to 61, whereby the organism is preferably selected from the group comprising mice, rats, guinea pigs, pigs, sheep, goats, cattle, horses, dogs and cats.

Group V, claim(s) **63-87, 89-103**, drawn to use of an adenovirus according to any of claims 1 to 53, a nucleic acid according to claim 54, a replication system according to claim 55 or 56, a vector according to any of claims 57 or 58, or a cell according to any of claims 59 to 61, for replication of an adenovirus, preferably for in vitro replication of an adenovirus.

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Group VI, claim(s) **88**, drawn to a pharmaceutical composition comprising an adenovirus according to any of claims 1 to 53, a nucleic acid according to claim 54, a replication system according to claim 55 or 56, a vector according to any of claims 57 or 58, or a cell according to any of claims 59 to 61 and optionally a pharmaceutically acceptable carrier.

The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking groups I-VI is an adenovirus an E1B protein and E4 protein. **Querido et al**, (Journal of Virology, 75(2): 699-709, 2001 (IDS) teach an adenovirus coexpressing E4orf6 and E1B55K which reduced the levels of and half life of p53 (abstract). Therefore the instant technical feature of Groups I-VI does not make a contribution over the prior art.

Claim 1 is generic to the following disclosed patentably distinct species: Claim is directed to structurally distinct E1B protein and E4 protein and E1A protein.

Claims 14-15, 17, 29, 31, 32, 34, 36, 38, 45-48 are generic to the following disclosed patentably distinct species: Claims are directed to structurally distinct tumor-specific promoters, organ-specific promoters, tissue-specific promoters, heterologous promoters and adenoviral promoters.

Claim 24 is generic to the following disclosed patentably distinct species: Claim is directed to structurally distinct adenoviral regions of E1 region, the E3 region and E4 region.

Claim 80 is generic to the following disclosed patentably distinct species: Claim is directed to structurally distinct cytokines, metalloproteinase inhibitors, angiogenesis inhibitors, cytostatics, tyrosine kinase inhibitors, cell cycle inhibitors, proteasome

inhibitors, inhibitors of the signal transduction cascade, protein kinases and recombinant antibodies.

Claims 96-97 are generic to the following disclosed patentably distinct species:
Claims are directed to structurally distinct histone deacetylase inhibitors Trichostatin A, FR 901228, MS-27-275, NVP-LAQ824, PXD 101 Apicidin and Scriptaid.

Claim 99 is generic to the following disclosed patentably distinct species: Claim is directed to structurally distinct topoisomerase inhibitors, Camptothecin, Irinotecan, Topotecan, DX-8951f, SN-38, 9-aminocamptothecin, 9-nitrocamptothecin, Daunorubicin and Etoposid. The species are independent or distinct because as disclosed the different species have mutually exclusive characteristics for each identified species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species, including any claims subsequently added. An argument that a

claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement

may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

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Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise

require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MAGDALENE K. SGAGIAS whose telephone number is (571)272-3305. The examiner can normally be reached on 8.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paras Peter can be reached on 571-272-4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Anne-Marie Falk/

Anne-Marie Falk, Ph.D.

Primary Examiner, Art Unit 1632